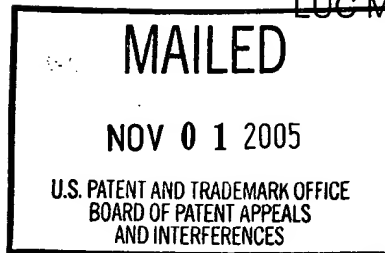


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARC ALIZON,
FRANCOIS BARRE SINOUSI, PIERRE SONIGO,
PIERRE TIOLLAIS, JEAN-CLAUDE CHERMANN,
LUC MONTAGNIER and SIMON WAIN-HOBSON



Appeal No. 2005-0398
Application No. 08/384,248

ON BRIEF

Before WILLIAM F. SMITH, MILLS and GRIMES, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request rehearing of our decision of July 12, 2005 in which we affirmed the examiner's rejection of claims 34-36 under 35 U.S.C. § 112, first paragraph (written description).

The request for rehearing has two aspects. First, appellants believe that we overlooked the inherent disclosure of raising antibodies set forth in the present specification. Request, page 2. Second, appellants believe that we misconstrued

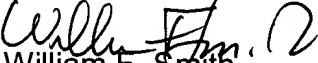
appellants' claims in reaching our decision and, in effect, raised a new ground of rejection. Id. Appellants state that "if, in fact, the Board has raised a new ground of rejection, Appellants request that, instead of consideration of this Request, the accompanying Amendment be entered and prosecution reopened." Id.

In considering the matter, we find that our affirmance of the examiner's rejection under the written description requirement of the first paragraph of § 112 was based upon a theory different from that set forth by the examiner. As such, it appears that appellants have not had a full and fair opportunity to react to the thrust of the rejection. In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976).

Accordingly, we denominate our affirmance of the examiner's rejection as a new ground of rejection under 37 CFR § 41.50(b). As set forth above, appellants have submitted a proposed amendment and requested that prosecution be reopened. Therefore, appellants have elected to proceed under the provisions of 37 CFR § 41.50(b)(1). Accordingly, we remand the case to the examiner to consider the amendment filed concurrently with the request for rehearing and take whatever action is deemed appropriate.

We have granted appellants' request for rehearing to the extent we have
denominated our affirmance as a new ground of rejection under 37 CFR § 41.50(b).

GRANTED-IN-PART; REMAND


William F. Smith

Administrative Patent Judge


Demetra J. Mills

Administrative Patent Judge



Eric Grimes
Administrative Patent Judge

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ELD

Appeal No. 2005-0398
Application No. 08/834,248

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